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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,876	01/29/2002	Taiji Sasage	1614.1211	2384

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STAAS & HALSEY LLP  
SUITE 700  
1201 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER

PICH, PONNOREAY

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/057,876

Applicant(s)

SASAGE ET AL.

Examiner

Ponnoreay Pich

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

AD

### **DETAILED ACTION**

Claims 1-6 are pending.

#### ***Priority***

The examiner recognizes applicant's right to an earlier effective filing date due to the current application being a continuation of Japanese application 2001-020404 filed on 1/29/2001.

#### ***Specification***

The abstract of the disclosure is objected to because there appears to be some translation problems with the abstract which makes it difficult to follow at times. For instance, instead of "transmitting", the examiner believes applicant may have meant "transmitted". Correction is required. See MPEP § 608.01(b).

The disclosure is objected to because of the following informalities: Like the abstract, the rest of the specification contains numerous translation errors which makes the specification difficult to follow at times or even incomprehensible at times. Applicant's cooperation is requested in clearing up translation errors found throughout the specification.

Appropriate correction is required.

#### ***Claim Objections***

Claims 1 and 4 are objected to because of the following informalities:

1. Line 7 of claim 1 and line 9 of claim 4 recites "a same as". The examiner believes applicant may have meant "the same as".

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2. As per claims 3 and 6, step (e) recites, "to report electronic mail". The examiner believes applicant meant to recite "to a report electronic mail".
3. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. As per claim 1, it is unclear how an electronic mail can be transmitting through a network. The examiner believes applicant may have meant "transmitted."
2. Step (b) of claim 1 is awkwardly worded, rendering the meaning unclear. For example, it is unclear what the electronic mail indicates for the second address. Also, instead of "a same type of", perhaps applicant meant "of same type as".
3. Claim 2 recites "the electronic mail detected in said step (a)". There is no electronic mail recited in step (a) of claim 1 that was detected. The examiner assumes applicant may have meant to just recite in claim 2: "reporting the mail virus detection in said step (a) to at least one predetermined report-to address."
4. Claim 2 recites "the step of (c)" which lacks antecedent basis. Perhaps applicant meant "the step of: (c)".

5. Step (d) in claim 3 recites compressing the electronic mail detected in step (a).  
No mail being detected is mentioned in step (a).
6. The last limitation of claim 3 is worded awkwardly, rendering the meaning unclear.  
For example, from the way it is currently worded, it is unclear what does the attaching.
7. Claims 4-6 are substantially similar to claims 1-3 and contain similar problems.
8. Any claims not specifically addressed are rejected by virtue of dependency.
9. Appropriate corrections are required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leeds (US 2002/0016824) in view of Smithson et al (US 6,898,715).

#### **Claims 1 and 4:**

Leeds discloses the limitations of:

- (a) Determining whether or not a first address indicated by the electronic mail, i.e. the address in the "From" field, transmitted through the network is the same as a second address, i.e. an address in a database (p4, paragraph 37, lines 15-18).

- (b) Suppressing sending other electronic mail being of same type as the electronic mail when said step (a) determines that the electronic mail indicates the second address (p4, paragraph 37, lines 18-21 and p4, paragraph 36, lines 19-22).

Leeds does not disclose the determining in step (a) is for mail virus detection and that the electronic mail indicates the second address for the mail virus detection. However, Leeds's teachings are directed towards preventing delivery of unwanted emails, i.e. spam emails. The examiner asserts that virus emails are another type of unwanted emails known at the time applicant's invention was made and it was known in the art at the time applicant's invention was made to also prevent delivery of virus emails. The examiner further notes that it is known in the art for spam emails to contain viruses and viruses to send spam messages which contain copies of the virus.

Smithson further discloses emails sent by computer viruses to propagate via the use of an email address book (col 6, line 66-col7, line 6). Smithson discloses determining done for mail virus detection (col 3, lines 47-51 and col 4, lines 24-27). Note that Smithson includes teachings directed towards preventing the spread of unwanted emails also, i.e. virus infected emails (col 6, line 66-col 7, lines 13).

In light of the above, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified Leeds's invention according to the limitations recited in claims 1 and 4. One of ordinary skill would have been motivated to do so as it would allow Leeds's invention to better prevent spread of spam messages generated by computer viruses.

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**Claims 2 and 5:**

Leeds does not explicitly disclose the step of: (c) reporting the mail virus detection in said step (a) to at least one predetermined report-to address. However, this limitation is obvious to the combination invention of Leeds and Smithson.

Smithson discloses reporting the mail virus detection in said step (a) to at least one predetermined report-to address (col 3, lines 58-64 and col 6, lines 27-36). One of ordinary skill would have been motivated to combine Leeds and Smithson's teachings for the same reasons given in claims 1 and 4.

**Claims 3 and 6:**

Leeds does not explicitly disclose the steps of:

(d) Compressing the electronic mail detected in said step (a).

(e) Attaching the electronic mail compressing said step (d) to a report electronic mail for reporting the mail virus detection.

Wherein said step (c) reports the mail virus detection by the sending report electronic mail attaching the electronic mail compressed in said step (d).

However, the examiner notes that compressing electronic messages/mails before sending the message/mail was well known in the art at the time applicant's invention was made. It would have been obvious to one of ordinary skill in the art to first compress electronic mail before sending because it would allow the mail to be delivered faster and the mail to take up less storage space in the receiver's hard drive.

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Further, Smithson discloses automatically sending computer files suspected of being infected with a computer virus to a repository so that they may be analyzed (col 3, lines 58-64 and col 6, lines 27-36). This reads on attaching the infected electronic mails to a report electronic mail for reporting the virus detection.

In light of the above, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified Leeds and Smithson's combination invention according to the limitations recited in claims 3 and 6. One of ordinary skill would have been motivated to send the electronic mail to report mail virus detection because that would allow an administrator to determine what type of virus was sent to determine countermeasures. One of ordinary skill would be motivated to compress the email before sending for the reasons given above.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ponnoreay Pich whose telephone number is 571-272-7962. The examiner can normally be reached on 8:00am-4:30pm Mon-Fri.

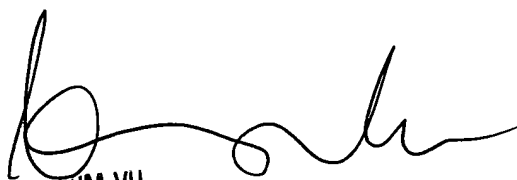
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ponnoreay Pich  
Examiner  
Art Unit 2135

PP



KIM VU  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100